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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/245,723 05/18/94 GREGOREK

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EXAMINER

26M1/0912

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ART UNIT PAPER NUMBER

2601

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DATE MAILED: 09/12/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892. (2 sheets)
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 1-11 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

1. The drawings are objected to because of the element in the lower right corner of FIG. 1, labeled "NETWORK...DEVICE", which inexplicably is outlined in dashed lines, which has no reference number, and which is not found to be identified as such in the text. Correction is required.

A proposal (with sketches) for correction of the drawings is required in response to this action. However, execution of the corrections may be delayed until allowable subject matter may be identified by the examiner.

2. Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. It is unclear what constitutes "remotely located" (emphasis added).

3. Claims 1 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,321,740 in view of the former two claims obviously being broadened forms of the latter, and thus clearly obvious thereover. The present claims obviously were written by changing the term "telephone" in the parent case's claims to "communications" (when an adjective) or "station" or "network address" (when a noun), thus somewhat generalizing the claims' terminology, while not otherwise substantially changing its requirements. Thus, the claims herein are *prima facie* obvious over the claims of the patent. Furthermore, note that dependent claims 2-6 herein are substantial duplicates of respective dependent claims 6, 11, 4, 5 and 7 of the patent.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent.

*In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d). Applicants' attention also is directed to 37 CFR § 3.73(b), and especially the last sentence thereof, whose language must be closely followed in the terminal disclaimer, for it to be acceptable.

4. Upon applicants' submission of an acceptable terminal disclaimer in view of the above, and clarification or cancellation of claim 7, the claims should be allowable over the prior art for essentially the same reasons as were the claims of the parent application, the broadening of the claims herein with respect to those of the parent case not having been found to render them obvious over the prior art.

A recently issued patent of Gupta is cited as of interest. This patent is not applicable to applicants' claims herein, both because it has a filing date later than that of the parent of this case, and also because it is not found to teach or suggest the combinations claimed herein.

The references cited in the parent case are cited herein, to complete the record; however, no copies of references previously supplied to applicants are provided.

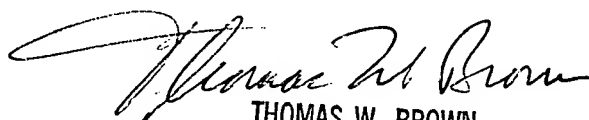
5. It is noted that applicants filed three copies of the drawings with the application. Applicants are urged not to submit more than a single copy of any papers to the Office unless specifically required by the rules, because excess copies only clutter the file and are sources of possible confusion for clerks, examiners or others who may need to handle the file.

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Art Unit: 2601

6. Any inquiry concerning this communication or earlier ones from the examiner should be directed to Thomas W. Brown whose telephone number is (703)305-4733. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-4750.

  
THOMAS W. BROWN  
PRIMARY EXAMINER  
GROUP 2601

TWBrown  
September 5, 1994